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09/863,232	05/21/2001	Greg Arnold	PALM-3649.US.P	9948

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WAGNER, MURABITO & HAO LLP
Third Floor
Two North Market Street
San Jose, CA 95113

EXAMINER
SHIN, KYUNG H

ART UNIT	PAPER NUMBER
2143	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	09/863,232	ARNOLD, GREG
	Examiner	**Art Unit**	
	Kyung H. Shin	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>05 April 2007</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-24</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-24</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

    1. ☐ Certified copies of the priority documents have been received.

    2. ☐ Certified copies of the priority documents have been received in Application No. _____.

    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Claims **1 - 24** are pending. No claim is amended. Independent Claims are **1, 12**

and 21.

Response to Arguments

2. Applicant's arguments filed 4/5/2007 have been fully considered but they are not persuasive.

2.1 The current set of prior art consists of **Multer (6,757,696) and Hoguta**

(6,725,303) references. (see Remarks Page 2)

2.2 Applicant argues new matter issue and the statement "while providing access to

other handheld devices for the information" (see Remarks Page 3-5)

The cited portion discloses access by multiple handheld devices. The term

"while" indicates access at the same time (i.e. "downloads the information to the

second handheld device while providing access to other handheld devices for

the information"). This procedure indicates downloading information to a

handheld device at the same time as providing the same information to other

handheld devices. There is no disclosure of this limitation in the specification or

the original claims. Applicant still has not show where in the specification the

concurrent access capability exists. If applicant feels the specification supports

these simultaneous procedures, please feel free to indicate the required

citations for confirmation. The Multer prior art already discloses access by

multiple handheld devices.

2.3   Applicant argues about the term "fairly suggest". (see Remarks 4-7)

No rejections in any Office Action are based on any indicated assumptions.   The

usage of the vague term, "fairly suggest", was merely indicated by the

Examiner.   Either Applicant feels the prior art teaches a claim limitation or

Applicant feels the prior art does not teach a claim limitation.

2.4   Applicant argues that the prior art teaches away. (see Remarks Page 8-11)

To teach away, a reference must criticize or discourage a particular embodiment

of an invention within a prior art.   Multer does not criticize, discredit, or

discourage the application of its user information to be utilized for a device.

The Applicant Invention's accounting information maintained for the device can

be application and application version information. *(see Specification Page 6,*

Lines 6-8) The accounting information maintained for the user can be

application and application version information. (see Multer col. 8, lines 40-44;

col. The information maintained for Applicant's invention and referenced prior

art are equivalent.

Applicant is reminded that, "the prior art's mere disclosure of more than one

alternative does not constitute a teaching away from any of these alternatives

because such disclosure does not criticize, discredit, or otherwise discourage

the solution claimed…." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141,

1146 (Fed. Cir. 2004).   (refer MPEP 2145.X.D.1)

There is no disclosure in Multer that discredits, discourages the usage of

information on a device basis.   If a single user for a single device, the

accounting information for that one device is equivalent to Applicant's Invention.

A profile is information about a particular entity, whether it is a user or a device.

In this situation, there is no fundamental difference between a user or a device.

The prior art's treatment of a user is equivalent to the Applicant Invention's

treatment of a device.

2.5   Applicant argues about the terms datapack and token. (see Remarks Page 11)

Multer does disclose the datapack which is a similar form to the token. It is not

a requirement to disclose a token, when the prior art named entity, the

datapack, performs an equivalent function. A token is defined as an entity to

identify information. A token causes the account to be modified *(see Remarks*

Page 11, Lines 14), and the referenced prior art's datapack causes particular

account information and data on the handheld device to be modified. The

Multer discloses a data package, which is utilized to identify information. (see

Multer col. 10, lines 26-31: data package, change information) The data

package is equivalent to the invention token.

2.6   Applicant argues the concept of versioning. (see Remarks Page 12-13)

Multer disclose a version number per object. (see Multer col. 12, lines 10-12),

and each application has an application object.   Multer discloses the

processing of application programs, its version information, and the capability to

match (i.e. synchronize) applications between systems (i.e. handheld devices).

(see Multer col. 12, lines 10-12; col. 15, lines 10-11; col. 15, lines 27-30:

application information processed)   Multer does disclose versioning

Lines 4-5) The Multer prior art discloses the processing of application programs and the capability to match (i.e. synchronize) applications between systems (i.e. handheld devices). (see Multer col. 15, lines 10-11 ; col. 15, lines 27-30: application information processed) Therefore, the rejection of claims 1-24 is proper and maintained herein.

2.7   Applicant argues about the terms user centric and device centric. (see Remarks Page 16)

There is no disclosure in Multer that discredits, discourages the usage of information on a device basis. If a single user for a single device, the accounting information for that one device is equivalent to Applicant's Invention. A profile is information about a particular entity, whether it is a user or a device. In this situation, there is no fundamental difference between a user or a device. The prior art's treatment of a user is equivalent to the Applicant Invention's treatment of a device.

2.8   Applicant argues about the determination of new information. (see Remarks Page 20)

The Multer prior art discloses information that is new to (i.e. first, second, and etc.) handheld devices. Information is on remote server and not in handheld device (i.e. new) and can be downloaded at a later time period. (see Multer col. 6, lines 4-12; col. 44, lines 48-54: information resides on server, information downloaded)

2.9 The examiner has considered the applicant's remarks concerning a method and system supporting web file sharing transactions between a networked handheld computer system and a server, which contains account information for each registered handheld indicating the applications (and versions) that it supports. Applicant's arguments have thus been fully analyzed and considered but they are not persuasive.

After an additional analysis of the applicant's invention, remarks, and a search of the available prior art, it was determined that the current set of prior art consisting of Multer (6,757,696) and Hoguta (6,725,303) discloses the applicant's invention including disclosures in Remarks dated April 5, 2007.

These rejections are set forth in prior Office Action, Paper No. 09863232\20061028 and reproduced for convenience.

Claim Rejections - 35 USC § 103

3. **Claims 1 - 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Multer et al.** (US Patent No. 6,757,696) and in view of **Hoguta et al.** (US Patent No. 6,725,303).

Regarding Claim 1, Multer discloses a method of transferring information comprising the steps of:

a) a first handheld device (see Multer col. 4, lines 27-34: handheld device utilized) causing an account (see Multer col. 32, lines 53-55: account information) to be accessed that is stored on a remote server, the account reserved for a second

handheld device and describing a complement of information stored in the

second handheld device; (see Multer col. 34, lines 16-19; col. 31, lines 58-62;

col. 16, lines 50-50: user accounting information for each user stored on)

b) the account modified to identify an information that resides on the remote server

but not on the second handheld device; (see Multer col. 17, lines 15-20; col. 32,

lines 14-17: user accounting information for particular user updated and stored

on server)

c) the second handheld device establishing a connection with the remote server;

(see Multer col. 5, lines 10-17; col. 6, lines 16-20: handheld device

communications between server and handheld device through connection) and

Multer discloses wherein the remote server automatically determining, from

the account, that the information is new to the second handheld device and in

response thereto for automatically downloading the information to the second

handheld device. (see Multer col. 34, lines 23-29: user information updated (i.e.

new information)) Multer does specifically discloses the capability to enable

access to user profile by another user.

However, Hoguta discloses:

d) wherein <u>while providing access to other handheld devices or the information</u>.

(see Hoguta col. 2, lines 23-29; col. 2, lines 44-49; col. 3, lines 11-20: access

profile information utilizing identifier information from network device)

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Multer to enable access to profile information by a user of

a network capable device as taught by Hoguta. One of ordinary skill in the art would be

motivated to employ Hoguta in order to enable uniform customization of services based

on profile and preferences information. (see Hoguta col. 1, lines 54-57: " ... *a need for*

providing a subscriber with a method of uniformly customizing the use of varied

terminals and services in accordance with a subscriber's preferences and purchased

entitlements ... ")

Regarding Claim 2, Multer discloses a method as described in Claim 1 further

comprising the step of the first handheld sending the remote server a token identifying

the information and the second handheld and wherein the token causes the account to

be modified by the remote server. (see Multer col. 37, lines 62-65: data pack (i.e. token)

used for information transfer utilized for update)

Regarding Claims 3, 14, Multer discloses a method as described in Claims 1, 12

wherein the first and the second or the sender and the receiver handheld devices are

handheld computer systems. (see Multer col. 4, lines 27-36: two devices (i.e. handheld

devices) in communication)

Regarding Claims 4, 15, 23, Multer discloses a method as described in Claims 1, 12,

21 wherein the information is a version of an application program. (see Multer col. 12,

lines 10-12; col. 12, lines 16-20; col. 13, lines 3-7: version information processed)

Regarding Claims 5, 16, 24, Multer discloses a method as described in Claims 4, 15,

21 wherein the account comprises an application version record table comprising an

entry for each application stored in the second handheld device and wherein each entry

comprises: an application identifier; a version identifier; and a user identifier. (see Multer

col. 38, lines 3-5 col. 38, lines 8-15; col. 38, lines 55-59: identifiers utilized to designate

contents within table entries)

Regarding Claim 6, Multer discloses a method as described in Claim 1 wherein the

step of automatically downloading the information to the second handheld device, of

step d), is performed only if the first handheld device has authority to download to the

second handheld device. (see Multer col. 33, lines 13-17; col. 34, lines 23-29; col. 5,

lines 17-21: authentication for device based on account information, download

information)

Regarding Claims 7, 18, Multer discloses a method as described in Claims 6, 17

wherein the authority is established via an express grant of permission from the second

handheld device to the first handheld device. (see Multer col. 34, lines 16-19:

authorization for device based on account information)

Regarding Claims 8, 19, Multer discloses a method as described in Claims 6, 17

wherein the authority is established via a user confirmation that is made in response to

a user message displayed on a display screen of the second handheld device. (see

Multer col. 12, lines 29-36; col. 32, lines 23-28: user interface)

Regarding Claims 9, 20, Multer discloses a method as described in Claims 1, 12

wherein the remote server is a web based server. (see Multer col. 31, lines 21-23: web

based (i.e. HTTP) server)

Regarding Claim 10, Multer disclose a method as described in Claim 1 wherein the

step d) is performed within a synchronization process between a remote server and the

second handheld device. (see Multer col. 7, lines 58-64; col. 14, lines 18-19:

synchronization process for information within server and handheld device)

Regarding Claim 11, Multer disclose a method as described in Claim 1 wherein the

step d) is performed within a synchronization process between a host computer system

and the second handheld device. (see Multer col. 7, lines 58-64; col. 14, lines 18-19:

synchronization process for information in server and two devices (i.e. host system and

handheld device))

Regarding Claim 12, Multer discloses a system comprising:

   a) a receiver handheld device; (see Multer col. 4, lines 25-36; col. 5, lines 17-21:

   receiver system (i.e. handheld device))

   b) a remote server containing an account reserved for the receiver handheld device

   which describes a complement of information stored in the receiver handheld

device; (see Multer col. 17, lines 15-20; col. 32, lines 14-17; col. 16, lines 50-50:

server management system for user accounting information)

c) a sender handheld device for causing the account to be modified to identify an

information that resides on the remote server but not on the second handheld

device; (see Multer col. 33, lines 13-17: update information within server system)

d) wherein the receiver handheld device is for establishing a connection with the

remote server; (see Multer col. 5, lines 10-17; col. 8, lines 16-19: handheld

device communicating through connection between server and handheld device)

and

Multer discloses wherein the remote server is for automatically determining,

from the account, that the information is new to the receiver handheld device and

automatically for downloading the information to the receiver handheld device.

(see Multer col. 34, lines 23-29: user information updated (i.e. new information))

Multer does specifically discloses the capability to enable access to user profile

by another user.

However, Hoguta discloses:

e) wherein while providing access to other handheld device for the information. (see

Hoguta col. 2, lines 23-29; col. 2, lines 44-49; col. 3, lines 11-20: access profile

information utilizing identifier information from network device)

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Multer to enable access to profile information by a user of

a network capable device as taught by Hoguta. One of ordinary skill in the art would be

motivated to employ Hoguta in order to enable uniform customization of services based on profile and preferences information. (see Hoguta col. 1, lines 54-57)

Regarding Claim 13, Multer discloses a system as described in Claim 12 wherein the sender handheld is for sending the remote server a token identifying both the information and the receiver handheld and wherein the token causes the remote server to modify the account. (see Multer col. 5, lines 17-21; col. 6, lines 16-20; col. 37, lines 62-65: data pack (i.e. token) utilized to modify user information)

Regarding Claim 17, Multer discloses a system as described in Claim 12 wherein the remote server is also for determining if the sender handheld device has authority to download to the receiver handheld device as a precursor to downloading the information to the receiver handheld device. (see Multer col. 4, lines 25-36; col. 6, lines 16-20: authorization for device, download information to device)

Regarding Claim 21, Multer discloses a system comprising:

   a) a receiver handheld computer; (see Multer col. 4, lines 25-36; col. 5, lines 17-21: receiver system (i.e. handheld device))

   b) a web based server containing an account reserved for the receiver handheld computer which describes a complement of information stored in the receiver handheld computer; (see Multer col. 31, lines 21-23: web based (i.e. HTTP) server)

c) a sender handheld computer for causing the account to be modified to identify an

information that resides on the web based server but not on the receiver

handheld computer; (see Multer col. 17, lines 15-20: update accounting

information managed within management (i.e. web based)server)

d) wherein the receiver handheld computer is for establishing a connection with the

web based server; (see Multer col. 5, lines 10-17; col. 6, lines 16-20: handheld

device communicating through connection between server and handheld device)

and

, Multer discloses wherein the web based server automatically determines,

from the account, that the information is new to the receiver handheld computer,

also determines if the sender handheld computer has authority to download to

the receiver handheld computer, and, if so, automatically downloads the

information to the receiver handheld computer. (see Multer col. 34, lines 23-29:

update user information (i.e. new information)) Multer does specifically discloses

the capability to enable access to user profile by another user.

However, Hoguta discloses:

e) wherein <u>while providing access to other handheld devices for the information</u>.

(see Hoguta col. 2, lines 23-29; col. 2, lines 44-49; col. 3, lines 11-20: access

profile information utilizing identifier information from network device)

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Multer to enable access to profile information by a user of

a network capable device as taught by Hoguta. One of ordinary skill in the art would be

motivated to employ Hoguta in order to enable uniform customization of services based on profile and preferences information. (see Hoguta col. 1, lines 54-57)

Regarding Claim 22, Multer discloses a system as described in Claim 21 wherein the sender handheld is for sending the remote server a token identifying both the information and the receiver handheld and wherein the token causes the web based server to modify the account. (see Multer col. 17, lines 15-20; col. 37, lines 62-65: data pack (i.e. token) used to manage user accounting information within management server (i.e. remote server))

Conclusion

4.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyung H. Shin whose telephone number is (571) 272-3920. The examiner can normally be reached on 9:30 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

<div style="text-align:right">

K H S
Kyung H Shin
Patent Examiner
Art Unit 2143

</div>

KHS
7/6/07

<div style="text-align:right">

DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

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